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CASE NO. 3:14-cv-02235-DMS-BLM
(lead case);
CASE NO. 3:14-cv-1507-DMS-BLM
(consolidated)

APPLE INC.'S SUR-REPLY IN OPPOSITION TO DEFENDANT WI-LAN, INC.'S MOTION TO COMPEL

Dept: 13A
Judge: Hon. Dana M. Sabraw
Magistrate Judge: Hon. Barbara L. Major

1 The Stanwood declaration does not make relevant all (or even most) of the
 2 requested communications between Apple and third parties regarding the Mobile
 3 WiMAX standard—communications that indisputably happened many years after
 4 Mr. Stanwood filed the applications to which the asserted patents claim priority—or
 5 certain Apple agreements with Qualcomm. The Court should deny Wi-LAN’s
 6 broad request for these communications and agreements or, at a minimum, limit the
 7 scope of Wi-LAN’s request, particularly because (a) the requested communications
 8 and agreements are irrelevant, and (b) Wi-LAN’s ESI and Email requests already
 9 request “WiMAX” documents, so Wi-LAN is already getting any “WiMAX”
 10 documents and/or communications from 15 Apple custodians of its own choosing.
 11 Thus, Wi-LAN does not need any additional searches or custodians. However, to
 12 the extent the Court grants this portion of Wi-LAN’s motion to compel, the Court
 13 should only permit Wi-LAN to serve one additional “WiMAX” ESI and email
 14 search term to one Apple custodian given the significant “WiMAX” discovery that
 15 Apple already has agreed to provide.

16 Wi-LAN claims that, because the Stanwood declaration identifies three
 17 purported links between the Fixed and Mobile WiMAX standards, then all Apple
 18 communications with third parties about the Mobile WiMAX standard—as well as
 19 Apple communications and agreements with Qualcomm—are discoverable. Dkt.
 20 No. 189 at 9-10. Mr. Stanwood does not contend that the asserted patents cover the
 21 entire Mobile WiMAX standard (they do not), nor does he assert that the accused
 22 products practice the Mobile WiMAX standard (they do not). Nor could the
 23 asserted patents cover the entire Mobile WiMAX standard, since the Mobile
 24 WiMAX standard included new technologies for mobility (802.16e-2005) and did
 25 not even exist at the time of the claimed inventions. Dkt. No. 183-9. In fact, in Wi-
 26 LAN’s previous lawsuit against Ericsson, Mr. Stanwood testified that “[w]e weren’t
 27 really discussing using those [4G] terms at that point in time. This was the early
 28 days of broadband wireless access.” Dkt. No. 198-3, Stanwood Depo. at 262:12-

1 16.¹ Wi-LAN's attempt to dismiss this testimony as using "4G" only as a
 2 "marketing term" (Dkt. No. 201 at 4) is flatly contrary to Wi-LAN's substantive use
 3 of the term "4G" more than 60 times in its motion to compel. Dkt. No. 179. Mr.
 4 Stanwood also admitted that the Fixed WiMAX standard "dealt with the
 5 frequencies and the range above 10 gigahertz, which were line of sight, no multi-
 6 path, better used for fixed systems than mobile systems." Stanwood Depo. at
 7 281:13-282:5 (emphasis added).² Thus, nothing in the Stanwood declaration
 8 supports the conclusion that all communications regarding Mobile WiMAX or
 9 Apple's agreements with Qualcomm are discoverable, and Mr. Stanwood's
 10 previous testimony demonstrates that these documents have nothing to do with his
 11 patents.

12 Mr. Stanwood is not the only one to have distinguished Fixed versus Mobile
 13 WiMAX. Notably, Wi-LAN's own discovery requests define the "WiMAX
 14 Standards" (plural) as "all releases of the IEEE 802.16 specifications, including but
 15 not limited to IEEE 802.16-2004, IEEE 802.16e-2005, and IEEE 802.16-2009, and
 16 IEEE802.16m." Dkt. No. 179-2, Wi-LAN Ex. 15 at 128. A book titled "WiMAX:
 17 Standards and Security" published in 2008 takes the same approach, stating that
 18 "[t]wo very different families of WiMAX systems exist and should be treated
 19 separately: fixed and mobile WiMAX." Ex. K, emphasis added. And the white

20 ¹ Wi-LAN still refuses to produce the transcript from Mr. Stanwood's deposition
 21 and has recently stated it has no intention of doing so. Ex. L, 11/14 Hollander
 22 Letter ("Per the Court's Amended Case Management Order, the allegations in your
 23 November 6 letter are untimely and improper."). Wi-LAN claims it does not need
 24 to satisfy its basic discovery obligations because Apple did not ask Wi-LAN to
 25 produce additional documents or serve supplemental interrogatory responses within
 26 30 days of Wi-LAN having served its initial responses, in which Wi-LAN agreed to
produce the relevant discovery. *See, e.g.*, Ex. M at RFP Nos. 39 and 84 (agreeing
 27 to produce relevant documents in response to Apple's requests for production
 28 directed to prior litigation materials and licenses). Apple will be prepared to
 address this issue, including Wi-LAN's failure to engage in basic discovery it
 previously agreed to provide, at the November 27 hearing.

² This excerpt from the Stanwood deposition in the *Wi-LAN v. Ericsson* case does
 not appear in the excerpt submitted as Dkt. No. 198-3, but the quote appears in a
 publicly available expert report from that case. *See* 2015 WL 12744173, at ¶ 89.

1 paper published in April 2009 by one of Wi-LAN's purported WiMAX licensees,
 2 Tranzeo Wireless Technologies, Inc., makes the distinction between the two
 3 standards even more clear:

4 It is unfortunate that 802.16d fixed WiMAX and 802.16e
 5 mobile WiMAX share the same last name. There is
virtually no relevant relationship between the two
technologies. They are the broadband equivalent of
 6 apples and oranges.

7 Dkt. No. 198-4, "Fixed vs Mobile WiMAX: An Apples to Oranges Comparison of
 8 Two Wireless Broadband Technologies," emphasis added.³ The Federal
 9 Communications Commission ("FCC") also distinguishes Fixed versus Mobile
 10 WiMAX: "In fixed WiMAX networks, both the base stations and subscriber
 11 stations are stationary during use. In mobile WiMAX networks, subscriber stations
 12 (mobile and portable devices) may move during operation." Dkt. No. 198-5, FCC
 13 Report, 233 FCC Rcd. 9615 (2008).

14 Wi-LAN attempts to discount this evidence that Fixed and Mobile WiMAX
 15 standards had different purposes and architectures, yet that evidence demonstrates
 16 that Wi-LAN's overbroad requests seek communications and agreements that have
 17 nothing to do with the claimed inventions or Wi-LAN's infringement claims.
 18 Mobile WiMAX (a) does not relate to the asserted patents—which claim priority to
 19 patent applications filed years before the Mobile WiMAX standard came into
 20 being—and (b) does not relate to the accused products, which do not practice either
 21 WiMAX standard and never have. The Court therefore should deny Wi-LAN's
 22 request or, at a minimum, deny Wi-LAN's request for all communications related
 23 generically to "WiMAX Standards" and Apple agreements with Qualcomm,
 24 especially because Apple already has agreed to produce ESI and Email discovery
 25

26 ³Wi-LAN has not produced its license with Tranzeo either and stated on November
 27 14 that it has no intention of doing so because it was responsive to requests for
 28 production to which Wi-LAN responded more than 30 days ago, in which Wi-LAN
 agreed to provide responsive licenses. *See* Exs. L, M.

1 that hits on the term “WiMAX.”⁴ To the extent the Court does not deny Wi-LAN’s
2 request in its entirety, the Court should only permit Wi-LAN to serve one additional
3 “WiMAX” ESI and Email search term to one additional Apple custodian.

4 Dated: November 15, 2017

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6 By /s/ Sean C. Cunningham

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27 ⁴ Under the ESI Order, Wi-LAN was permitted to identify 15 ESI and email
28 custodians and was permitted to identify 20 ESI search terms and 10 email search
terms. Dkt. No. 130. Wi-LAN’s ESI and email requests included “Wi-MAX”
search terms, which Apple has agreed to run. Ex. N, 11/10 Schubert Letter.

CERTIFICATE OF SERVICE

I hereby certify that on November 15, 2017, I electronically transmitted the attached document to the Clerk's Office using the CM/ECF System for filing and transmittal of a Notice of Electronic Filing to the CM/ECF registrants.

/s/ Sean C. Cunningham
Sean C. Cunningham